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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,394	09/01/2005	Eiji Sunahara	Q101062	4910
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SUGHRUE MION, PLLC				
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800				
WASHINGTON, DC 20037				
EXAMINER				
DUFFY, BRADLEY				
ART UNIT		PAPER NUMBER		
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MAIL DATE		DELIVERY MODE		
10/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10/540,394	9/1/2005	SUNAHARA ET AL.	Q101062

## EXAMINER

BRADLEY DUFFY

ART UNIT	PAPER
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1643 20080807

DATE MAILED:

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Commissioner for Patents

## Notice of Non-Responsive Amendment

1. The amendment filed January 31, 2008, is non-responsive for the following reasons:

The amendment filed January 31, 2008, would amend all claims, which were previously drawn to the elected invention, so as to present only claims drawn to an invention that lacks unity with the invention originally claimed for the following reasons: The claims, as would be amended, are not readable on the elected invention for the following reasons:

In this case, the amendment filed January 31, 2008, changes the amino acids sequence of SEQ ID NO:1 over residues 384-389 from the amino acid sequence MVHRDP to the amino acid sequence: WYTVTH. Notably, at pages 3 and 4 of this amendment Applicant submits that the sequence listing as originally filed contains obvious typographical errors and that one of skill in the art would understand that SEQ ID NO:1 as originally filed should have the same amino acid sequence disclosed in GenBank™ Accession No. XM\_044533. As noted in the previous office action, Applicant's representative, Mr. William Simmons, apprised the Examiner of errors in the sequence listing on December 17, 2007, and indicated that Applicant intended SEQ ID NO: 1 to have the same exact amino acid sequence as disclosed by GenBank™ Accession No. XM\_044533 based on the disclosure bridging pages 72 and 73 that "[t]he amino acid sequence (SEQ ID NO: 1) encoded by the base sequence represented by SEQ ID NO: 2 completely coincided with SEMA4B protein encoded by SEMA4B gene (GenBank Accession No. XM\_044533 gene)". Therefore, the Examiner presumed that the Application was not in sequence compliance; yet upon further careful consideration of Applicants amendment, it is not immediately apparent that "obvious" typographical errors occurred, or that Applicant originally intended SEQ ID NO: 1 to have the same amino acid sequence as that which is disclosed by GenBank™ Accession No. XM\_044533.

By way of further explanation, according to Merriam-Webster Online Dictionary, the word "coincide" may be defined as meaning "to correspond in nature, character, or function" (© 2008 Merriam-Webster, Incorporated). Accordingly, it is not immediately apparent that Applicant originally intended SEQ ID NO: 1 to have the same amino acid sequence as that which is disclosed by GenBank™ Accession No. XM\_044533, or merely an amino acid sequence that corresponds in nature, character, or function to any SEMA4B polypeptide encoded by a SEMA4B gene. Notably, this position is supported because GenBank™ Accession No. XM\_044533 is presented in parentheses after the term "SEMA4B gene" as if merely exemplary of a SEMA4B gene. For these reasons, it is not immediately apparent that the alleged typographical error would be an "obvious" error, as Applicant has remarked.

Notably, the Examiner regrets any inconvenience these further considerations may cause Applicant, but it is submitted that the record should be made clear.

In addition, since Applicant would be relying upon the disclosure set forth under GenBank™ Accession No. XM\_044533 to provide support for the amendment, Applicant is reminded that M.P.E.P. § 608.01(p) does not provide for the incorporation by reference of essential material by reference to non-patent publications. "Essential material" is defined as "that which is necessary to

(1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112)". Accordingly, if there were support to amend SEQ ID NO:1 to have the same sequence as disclosed by GenBank™ Accession No. XM 044533, then such an amendment must be accompanied by an affidavit or declaration executed by Applicant, or a practitioner representing Applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See In re Hawkins, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); In re Hawkins, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and In re Hawkins, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

However, because the amendment filed January 31, 2008, changes the amino acids sequence of SEQ ID NO: 1 over residues 384-389 from MVHRDP to WYTVTH, and since the claims are drawn to an antibody that specifically binds a protein comprising the amino acid sequence of SEQ ID NO: 1, it is apparent that changing the amino acid sequence of SEQ ID NO: 1 changes the special technical feature from that originally presented and examined because the antibody now must specially bind to a structurally distinct antigen. Notably, this change in amino acid sequence would require a new and unique sequence search of the amended SEQ ID NO: 1 because e.g., a monoclonal antibody that specifically binds the antigen comprising the original amino acid sequence of SEQ ID NO:1 would not bind to other antigens. Accordingly, altering the original amino acid sequence of SEQ ID NO: 1 changes the special technical feature of the claims to an invention that lacks unity with the invention originally claimed because the claims now recite an antibody that specifically binds a different and distinct antigen than originally presented.

Accordingly, after entry of the amendment, all remaining claims would be withdrawn from consideration as being directed to non-elected inventions, and therefore the amendment, which presents only claims drawn to such non-elected inventions, is non-responsive and will not be entered. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brad Duffy whose telephone number is (571) 272-9935. The examiner can normally be reached on Monday through Friday 7:00 AM to 4:30 PM, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully,  
Brad Duffy  
Examiner, Art Unit 1643  
571-272-9935

/Stephen L. Rawlings/  
Primary Examiner, Art Unit 1643

/bd/  
Examiner, Art Unit 1643  
August 11, 2008